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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,999	10/25/2005	Junya Fujii	024918-0122	5954
22428 7590 08/15/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER SANDY, ROBERT JOHN	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 08/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,999	Applicant(s) FUJII ET AL.	
	Examiner Robert J. Sandy	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a **final** Office action responsive to the reply filed on 11 June 2007.

- Claims 1-4, 6, 7, and 9-12 were amended.
- Claims 1-12 are pending.

Specification

The abstract of the disclosure is objected to because it contains legal phraseology. The phrase "The present invention relates to a type B clip" should be changed to read to the effect of - - A type B clip....". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

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(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide an enabling disclosure teaching how to make the claimed invention, as to the following:

The specification fails to provide an enabling disclosure teaching how to make the claimed clip according to claim 4 requiring wherein “the latching means is constituted of the latching part having a male member and a female member, and of an elastic piece formed on one tip end of the opposed clipping arms and capable of oscillating with the use of the supporting point part as a fulcrum by the latching releasing means; one of the male member and the female member is formed on a tip end of the elastic piece; and the other of the male member and the female member is formed on an other tip end of the opposed clipping arms”. Since claim 1 has established “a latching means, disposed **on one end** of one of the opposed clipping arms, which has a latching part”, there is no enabling disclosure supporting where, **on one end of one of the opposed clipping arms**, there exists “the latching part having” both “a male member and a female member, and of an elastic piece formed on one tip end of the opposed clipping arms”.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japan document No 2002-321746, filed 25 April 2001, and published 05 November 2002, and cited by applicant).

Claims 1-3, 5, 6, and 9-11, are rejected under 35 U.S.C. 102(b) as being anticipated by Thoresen (U.S. Patent No. 2,271,133). Thoresen ('133) discloses a clip (1, 2), comprising: opposed clipping arms (1, 2) capable of forming an independent, separate space by pressing and holding there between a clipped object, a latching means (5, 14), disposed on one end of one (2) of the opposed clipping arms, which has a latching part (latch member 5) capable of latching the clipping arms which are pressing (via the elasticity of the compressed "elements 6 and 7"; col. 2, 1st and 2nd paragraphs) and holding the clipped object there between, and a latching releasing means (trigger 14) to which latching releasing force (force applied to trigger 14) is applied in an open direction (i.e., force applied to 14 in an open direction defined by an anti-clockwise rotational direction about member 5) of the opposed clipping arms (the open direction of body 2 relative to body 1 is in an anti-clockwise rotational direction about hinge 3), wherein the latching means has a supporting point part (end supporting portions of member 5) that acts as the latching releasing force to the latching part in a latching releasing direction (an anti-clockwise rotational direction about pintle 3 of body 2);

(concerning claim 2) the latching means is disposed at both ends of the opposed clipping arms;

(concerning claim 3) the latching part of the latching means is disposed at a latching releasing means side (member 5, see Fig. IV) of the supporting point part;

[Examiner's note concerning claims 5, 6, 8 and 11, where each of these claims are directed to a product-by-process claim wherein the process relied upon is results in an "integrally molded" feature as recited in each of the respective claims. These limitations to an integrally molded feature has not given an patentable weight since the structural limitations of the claimed product are met. And, therefore it has been held that if the product defined in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made from a different process. See *In re Thorpe*, 77 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).]

(concerning claim 5) the latching releasing means and the latching means are integral to each other;

(concerning claim 6) the latching releasing means, the latching means and the opposed clipping arms are integral to each other;

(concerning claim 9) the latching releasing means is comprised of a thread-like article (trigger 14, as best understood, is thread-like) or a thread-like article bound to an elastic piece (15) of the latching means;

(concerning claim 10) a structure (3) wherein the other end of the one of the opposed clipping arms on which the latching means is formed is bound by an axis (axis through hinge 3) in an oscillating way; and

(concerning claim 11) a structure (3) wherein the opposed clipping arms, on which the latching means is formed, is bound by a hinge (3) with the one of the clipping arms and formed on the other end, opposite the side where the latching means is formed, in an oscillating way.

Claim Rejections - 35 USC § 103

Claim 12, so far as definite, is rejected under 35 U.S.C. 103(a) as being unpatentable over Thoresen ('133) in view of Oh et al. (U.S. Patent No. 4, 834,096). Thoresen. ('272) discloses the claimed clip except for wherein at least the clipping arm is comprised of a resin made by mixing a glass fiber into a polyoxymethylene resin. However, Oh et al. ('096) discloses a clip made from "polyoxymethylene" (col. 9, line 26). Therefore, it would have been obvious to one of ordinary skill in the art to have manufactured the clip of Thoresen ('133) from a polyoxymethylene resin, as suggested by Oh et al. ('096), since Oh et al. ('096) recognizes that polyoxymethylene is a

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preferable suitable plastic material among “many relatively strong engineering plastics” when molding clip portions of “a single integral piece of molded plastic.” (col. 9, lines 20-23).

Response to Arguments

Applicant's arguments with respect to the claims rejected by the Robinson have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amendment.

Applicant's arguments concerning the claims rejected by the “Fujii” reference the have been fully considered but they are not persuasive, because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's submission of the Fujii reference (Japan document No 2002-321746, filed 25 April 2001, and published 05 November 2002) shows an identical clip of the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Sandy whose telephone number is 571-272-7073. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ROBERT J. SANDY
PRIMARY EXAMINER

Robert J. Sandy
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